

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACK G. SCARPA,
JOHN D. MARLIN,
TERRY HALL
and STEVEN A. COSBY

MAILED

FEB 10 2003

Appeal No. 2002-1666
Application 09/394,289

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

ON BRIEF

Before COHEN, FRANKFORT, and MCQUADE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Jack G. Scarpa et al. appeal from the final rejection of claims 1 through 7. Claims 8 through 10, the only other claims pending in the application, stand withdrawn from consideration as being drawn to a non-elected species of the invention.

THE INVENTION

The invention relates to "portable convergent spray guns for applying coatings to a surface and particularly to a portable spray gun that is miniaturized so as to be capable of being hand-

held or having the option of being either hand-held or robotically-held for use with a portable system" (specification, page 1).¹ Representative claim 1 reads as follows:

1. A portable convergent miniaturized spray gun including a handle, said spray gun having a central passage for flowing liquid resin and a concentric passage relative to the central passage for flowing pressurized air, and a nozzle internal of said spray gun for discharging the liquid resin from the central passage, a double concentric tube assembly having an additional central passage in axial alignment with said central passage for receiving resin from said internal nozzle, an additional concentric passage relative to said central passage in axial alignment with said concentric passage, a fluid tip mounted on the end of said additional central passage defining a central orifice for discharging the resin flowing from said central passage and said additional central passage, an air cap mounted over said fluid tip and defining with said fluid tip an air nozzle for flowing air into said resin stream discharging from said central orifice and defining an atomized convergent spray having a low pressure zone, said fluid tip including a circular shaped member abutting the inner surface of said air cap and having flats formed thereon to define gaps between said air cap and said circular shaped member to allow air from said concentric passage to flow therebetween and mix with the resin to atomize the resin flowing out of said central passage and a dry powdered nozzle having angled flow passages for directing dry powder into the low pressure zone of said atomized convergent spray.

¹ The appellants' disclosure contains an unusually high number of inconsistencies between the specification and the drawings.

THE PRIOR ART

The references relied on by the examiner as evidence of obviousness are:

Black	3,185,396	May 25, 1965
Schowiak	4,005,825	Feb. 1, 1977
Breitsprecher	5,419,491	May 30, 1995
Warren	5,645,217	Jul. 8, 1997

THE REJECTIONS

Claims 1 through 7 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the appellants, at the time the application was filed, had possession of the claimed invention.

Claims 1 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Black.

Claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Black in view of Breitsprecher.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Black in view of Schowiak.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Black in view of Schowiak and Warren.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Black in view of Schowiak, Warren and Breitsprecher.

Attention is directed to the appellants' main and reply briefs (Paper Nos. 19 and 23) and to the examiner's answer (Paper No. 20) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 112, first paragraph, rejection

In explaining this rejection, the examiner submits that "[t]he application as filed does not disclose 'said fluid tip including a circular shaped member abutting the inner surface of said air cap' as recited in amended claim 1" (answer, page 3). In other words, the examiner views the appellants' specification as failing to comply with the written description requirement of 35 U.S.C. § 112, first paragraph.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventors had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.

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In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The content of the drawings may also be considered in determining compliance with the written description requirement. Id.

Although the appellants contend (see pages 10 and 11 in the main brief) that the original disclosure provides the requisite support for claim limitation at issue in the discussion of the fluid tip element 70 and air cap 90 on specification page 15, line 3 et seq., they also have submitted a proposed amendment (Paper No. 21) "for curing the defect noted by the Examiner" (reply brief, page 1). The examiner, however, has refused entry of this amendment (see Paper No. 22), and the part of the specification relied on by the appellants does not in fact describe the circular shaped member (main body 78) of the fluid tip element (70) as abutting the inner surface of the air cap (90). In essence, the remarks contained in the reply brief and in the proposed amendment concede the existence of the problem addressed by the examiner's rejection. Hence, the appellants' argument that the disclosure of the application as originally filed would reasonably convey to the artisan that the appellants had possession at that time of the subject matter now recited in claim 1 is not persuasive.

We shall therefore sustain the standing 35 U.S.C. § 112, first paragraph, rejection of independent claim 1 and dependent claims 2 through 7.

II. The 35 U.S.C. § 103(a) rejections

Black, the examiner's primary reference, discloses a spray gun apparatus (see Figure 1) for applying a weather protective coating to a building structure. As described in the reference,

[t]he essential concept of this invention involves a plurality of tubular elements arranged one within the other through which viscous and solid substances simultaneously are pressured for discharge from the end of the outer element as an integrated mixture for impingement onto a surface requiring a protective coating.

An applicator embodying the foregoing concept comprises a plurality of tubular elements 11, 12 and 13, each with some form of a discharging nozzle 14, 15 and 16, respectively, arranged one within the other with their breech ends structured for connection, respectively, to sources of a solid substance [e.g., glass fiber], a viscous substance [e.g., asphalt], and air pressure, and their discharging nozzle ends 14, 15 and 16 so related as to cause the two substances to be integrated into an intimate mixture for discharge from the nozzle 14 of the outer element 11 for impingement as a lamina of predetermined pattern on a selected surface [column 1, lines 44 through 60].

Figure 4 shows the discharge ends of the tubular elements. Of particular interest is the construction of the nozzle 15. According to Black:

[t]he nozzle 15 is a dual structure including the extension 32 and a fitting 48 threaded on the inner, discharge end of the tube 11, as best shown in FIG. 4.

The extension 32 is formed with a circular discharge port 49 inwardly from which extends a taper bore 51. The fitting 48 is in the form of a threaded cap adjustable on the inner end of the inner tube 11 and having an axial discharge port 52. Such a fitting 48, being axially shiftable on the tube 11, serves a two-fold purpose. It regulates the air stream emitted from the one part of the hereinafter described dual-structured nozzle 16 and, also, influences the discharge of the viscous substance from the tube 11, into the chamber 44 in the extension 32, as indicated by the arrows at C in FIG. 4 [column 2, line 69, through column 3, line 10]

In applying Black to reject claim 1 (see pages 3 and 4 in the answer), the examiner finds correspondence between Black's fitting 48 and nozzle extension 32 and the "fluid tip" and "air cap" recited in the claim. Conceding that Black's fluid tip or fitting 48 does not include a circular shaped member having flats formed thereon to define gaps between the air cap and the circular shaped member as required by the claim, the examiner concludes that "[i]t would have been obvious to a person having ordinary skill in the art at the time of the invention to have added flats to the fluid tip of Black to accommodate a wrench" (answer, page 4). The examiner, however, has failed to advance any evidentiary basis to support this bald conclusion. Moreover, even if such a modification were made to the Black device, the resulting structure would still lack response to the claim limitation calling for the circular shaped member to abut the

inner surface of the air cap. Although Black's fluid tip or fitting 48 certainly embodies a circular shaped member, it does not abut the inner surface of the air cap or nozzle extension 32 (see Figure 4). The examiner's apparent dismissal of this limitation because it lacks written descriptive support in the specification (see page 7 in the answer) is not well taken. When evaluating claims for obviousness under § 103(a), all of the limitations recited therein must be considered and given weight, even those which do not find support in the specification as originally filed. See MPEP § 2143.03.

In light of the foregoing, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 1, and dependent claim 4, as being unpatentable over Black.

As the examiner's application of Breitsprecher, Schowiak and/or Warren does not cure the above noted deficiencies of Black relative to the subject matter recited in parent claim 1, we shall not sustain the standing 35 U.S.C. § 103(a) of dependent claims 2 and 3 as being unpatentable over Black in view of Breitsprecher, the standing 35 U.S.C. § 103(a) of dependent claim 5 as being unpatentable over Black in view of Schowiak, the standing 35 U.S.C. § 103(a) of dependent claim 6 as being unpatentable over Black in view of Schowiak and Warren, or the

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standing 35 U.S.C. § 103(a) of dependent claim 7 as being unpatentable over Black in view of Schowiak, Warren and Breitsprecher.

SUMMARY

As at least one rejection of each of the appealed claims is sustained, the decision of the examiner to reject claims 1 through 7 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IRWIN CHARLES COHEN
Administrative Patent Judge

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge

JOHN P. MCQUADE
Administrative Patent Judge

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NORMAN FRIEDLAND
11300 US HIGHWAY ONE
SUITE 400
NORTH PALM BEACH, FL 33408